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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,748	10/04/2000	Makoto Sakakibara	54030USA7A.0	3966
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3M INNOVATIVE PROPERTIES COMPANY				
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ST. PAUL, MN 55133-3427				
			EXAMINER	
			CHANG, VICTOR S	
		ART UNIT	PAPER NUMBER	
		1771		

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,748

Applicant(s)

SAKAKIBARA, MAKOTO

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner has carefully considered Applicant's remarks filed on 11/14/2003.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The amount of the short fibers set forth in the two Markush groups are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The Examiner repeats (see section 5 of Paper No. 17) that in claims 1 and 2, Applicant fails to clarify the limitation of "the short fibers". More particularly, the improper "comprising" clause reads on embodiments which possess only trace amounts of the fibers set forth in the two Markush groupings and as such render the instantly claimed invention unduly broad, as the claims read on almost any conceivable fiber grouping.

Additionally, with respect to Applicants' response arguing that the specification at page 3, lines 20-24, provides the support for claim 6, the Examiner repeats (see Paper No. 17, page 2) that it appears from the Specification (e.g., Example 1 at page 8 of

Specification) that the amount, length and compositions of the short fibers are the point of novelty, as otherwise the extremely broad claim reads upon the prior art. In other words, the specification at page 3, lines 20-24, lacks the required enablement for one of ordinary skill in the art to make and use the instant claimed invention.

Response to Amendment

5. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over NITTO DENKO CORP in view of Canary, substantially for the reasons set forth in section 6 of Paper No. 17, together with the following additional observations.

With respect to Applicant's response arguing that "No reference teaches short fibers having both a length within the range of about 3 to 20 mm and comprising a material selected from ..." (Remarks, page 4, 6th paragraph), the Examiner repeats (see section 5 of Paper No. 17) that in section 4 of Paper No. 4, the Examiner has clearly provided a reference by Canary as teaching a wood pulp has a fiber length between 2 and 5 mm, which reads on the instant claimed short fiber length within the range of about 3 to 20 mm. Further, the Examiner repeats that it appears that whether the Markush group is open or close ended is irrelevant to the prior art reference by Canary's wood fiber, since the improper transitional term "comprising" fails to exclude the wood pulp fiber taught by Canary.

With respect to Applicants' argument that "Canary teaches that in one layer, the quantity of polyolefin is greater than the quantity of wood pulp" (Remarks, page 5, 4th full paragraph), the Examiner repeats (see section 6 of Paper No. 17) that that Canary

teaches that layer 1 generally has between about 10 and 40 wt. % polyolefin fibers; the fibrils of the polyethylene have an average length between about 0.6 and 1.2 mm and a maximum length of about 2.5 mm. Layer 1 also contains a softwood pulp fibers with an average length between about 2 and 5 mm. Further, layer 2 generally has between about 40 and 80 wt. % polyolefin (column 3, lines 49-60). In the absence of the fiber length in claim 6, the Examiner determines that the polyolefin fibers taught by Canary is "short fiber", i.e., shorter than pulp fibers. As such, Canary's teaching clearly reads on the limitation of the instant claimed invention as both layers having a blend of polyolefin short fibers to wood pulp less than 50%, Applicants' argument to the contrary notwithstanding.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1999

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Daniel Zinker